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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91182515
Party	Defendant Mark/Space, Inc.
Correspondence Address	ROBERT B. BURLINGAME PILLSBURY WINTHROP SHAW PITTMAN LLP P.O. BOX 7880 CALENDAR/DOCKETING DEPARTMENT SAN FRANCISCO, CA 94120-7880 sftrademarks@pillsburylaw.com
Submission	Answer and Counterclaim
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Signature	/Robert B. Burlingame/
Date	03/31/2008
Attachments	SYNCTOGETHER answer.pdf (7 pages)(30792 bytes)

Registrations Subject to Cancellation

Registration No	3321524	Registration date	10/23/2007
Registrant	T-Mobile USA, Inc. 12920 S.E. 38th Street Bellevue, WA 98006 UNITED STATES		
Goods/Services Subject to Cancellation	Class 038. First Use: 2006/09/20 , First Use In Commerce: 2006/09/20 Goods/Services:		
Registration No	3321523	Registration date	10/23/2007
Registrant	T-Mobile USA, Inc. 12920 S.E. 38th Street Bellevue, WA 98006 UNITED STATES		
Goods/Services Subject to Cancellation	Class 036. First Use: 2006/09/20 , First Use In Commerce: 2006/09/20 Goods/Services:		
Registration No	3321522	Registration date	10/23/2007
Registrant	T-Mobile USA, Inc. 12920 S.E. 38th Street Bellevue, WA 98006 UNITED STATES		
Goods/Services Subject to Cancellation	Class 035. First Use: 2006/09/20 , First Use In Commerce: 2006/09/20 Goods/Services:		
Registration No	3363610	Registration date	01/01/2008
Registrant	T-Mobile USA, Inc. 12920 S.E. 38th Street Bellevue, WA 98006 UNITED STATES		

Goods/Services Subject to Cancellation	Class 009. First Use: 2006/09/20 , First Use In Commerce: 2006/09/20 Goods/Services:
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

_____)	
T-MOBILE USA, INC.,)	Opposition
)	No. 91182515
Opposer,)	
)	
v.)	Ser. No. 77081277
)	Mark: SYNCTOGETHER
MARK/SPACE, INC.,)	
)	
Applicant.)	
_____)	

ANSWER & COUNTERCLAIM TO NOTICE OF OPPOSITION

Commissioner for Trademarks
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

Dear Sir or Madam:

Applicant, Mark/Space, Inc., by its attorneys, responds as follows to the Notice of Opposition, dated February 19, 2008, filed by T-Mobile USA, Inc.

For its answer to the numbered paragraphs in the Notice of Opposition, Applicant avers as follows, with the following paragraph numbers corresponding to the numbered paragraphs in the Notice of Opposition:

1. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the averments, and denies same.
2. Admitted.

3. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the averments, and denies same.

4. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the averments, and denies same.

5. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the averments, and denies same.

6. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the averments, and denies same.

7. Admitted, except with respect to the recitation of services in International Class 38, which should read: “Communication services enabling computer users to share data and electronic files between electronic devices or between users”.

8. Admitted.

9. Denied.

10. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the averments, and denies same.

11. Denied.

12. Denied.

AFFIRMATIVE DEFENSES

Opposer’s claims are barred by laches, estoppel and acquiescence.

COUNTERCLAIM
FOR CANCELLATION OF U.S. TRADEMARK REGISTRATION
NOS. 3321524, 3321523, 3321522 and 3363610

1. Applicant is a California corporation which is in the business of developing cutting-edge wired and wireless synchronization software products.

2. Applicant has applied to register the mark SYNCTOGETHER (Application Ser. No. 77081277) for: “computer and telecommunications software that enables others to connect with and share data and electronic files between computers, electronic devices and other users” (in Class 9); “communication services enabling computer users to share data and electronic files between electronic devices or between users” (in Class 38); “electronic storage of data, files and documents” (in Class 39); and “providing temporary use of online non-downloadable software for sharing data and electronic files between electronic devices or between users; computer services, namely, hosting and maintaining an online website to assist others with sharing data and electronic files between electronic devices or between users; and computer services, namely, acting as an application service provider in the field of knowledge management to host computer application software for sharing data and electronic files between electronic devices or between users” (in Class 42).

3. Opposer, T-Mobile USA, Inc., has averred prior use and registration of its marks, and that Applicant’s mark is likely to cause confusion.

4. Opposer has opposed Applicant’s Application Ser. No. 77081277 based on Opposer’s applications and registrations for the phrase STICK TOGETHER and its Spanish equivalent, ESTAMOS JUNTOS, including U.S. Trademark Registration Nos. 3321524, 3321523, 3321522 and 3363610 for the phrase STICK TOGETHER.

5. Opposer's U.S. Trademark Registration No. 3321524 is for the phrase STICK TOGETHER for "telecommunications services, namely, wireless voice and data transmission, two way wireless transmission of email and text between wireless telecommunication terminals and computers, and providing multiple-user access to a global computer network" in Class 38.

6. Opposer's U.S. Trademark Registration No. 3321523 is for the phrase STICK TOGETHER for "prepaid wireless communications calling card services" in Class 36.

7. Opposer's U.S. Trademark Registration No. 3321522 is for the phrase STICK TOGETHER for "retail store services and online retail services featuring wireless telecommunications and information technology equipment, namely, wireless telephones, wireless modems, wireless handheld computers, and related accessories, namely, antennas, smart cards containing programming used to interact with a wireless telephone or handheld computer and respond to a signal contact that requests customer identification and account information, carrying cases for wireless telephones and computers, hands-free microphone and earphone adapters, headset adapters, wireless telephone and handheld computer mounts, batteries, battery chargers, faceplates and related accessories" in Class 35.

8. Opposer's U.S. Trademark Registration No. 3363610 is for the phrase STICK TOGETHER for "wireless telecommunications and information technology equipment, namely, wireless telephones, wireless modems, wireless handheld computers, and related accessories, namely, smart cards containing programming used to interact with a wireless telephone or handheld computer and respond to a signal contact that requests customer identification and account information, carrying cases for wireless telephones and computers, hands-free microphone and earphone adapters, headset adapters, batteries, battery chargers" in Class 9.

9. Opposer's U.S. Trademark Registration Nos. 3321524, 3321523, 3321522 and 3363610 should not have been issued because the registered phrase STICK TOGETHER is merely a popular slang phrase that is devoid of distinctiveness and incapable of serving as a trademark.

10. The phrase STICK TOGETHER is a common, familiar expression and slogan and is needed by other companies in Opposer's industry to effectively compete.

11. The phrase STICK TOGETHER is too common and non-distinctive to justify granting Opposer exclusive trademark rights in that phrase, even upon a showing of secondary meaning.

12. Opposer should not be permitted to prevent general use of the common phrase STICK TOGETHER by registering it in connection with certain goods and services.

13. The phrase STICK TOGETHER, as used by Opposer, descriptively conveys a message and is unlikely to be recognized by consumers as a source indicator or trademark.

14. Even in the unlikely event that the phrase STICK TOGETHER is deemed capable of trademark protection, Opposer's use of the phrase STICK TOGETHER is merely descriptive and that phrase has not yet achieved trademark status or secondary meaning for all of the goods and services covered in Opposer's U.S. Trademark Registration Nos. 3321524, 3321523, 3321522 and 3363610.

15. The descriptive nature of the phrase STICK TOGETHER is visible from Opposer's own webpage at http://www.t-mobile.com/Company/CompanyInfo.aspx?tp=Abt_Tab_CompanyOverview, on which Opposer states, "The value of our plans, the breadth of our coverage, the reliability of our network, and the quality of our service are meant to do one thing: help you stick together with the people who make your life come alive."

WHEREFORE, Applicant prays that:

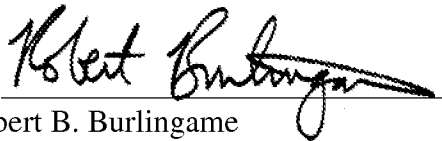
1. the Board find that there is no likelihood of confusion between (i) Opposer's U.S. Trademark Application Nos. 78899714, 78899716, 77249930, 77249949, 77249962, 77250294, 77250301, 77250393 and 77250442, and Registration Nos. 3321524, 3321523, 3321522, 3363610, 3363709, 3363710, 3398296, 3398295, 3398294, 3398293, 3398292 and 3398289 and (ii) Applicant's Application Ser. No. 77081277;
2. the Board find that there is no likelihood of confusion between the mark SYNCTOGETHER and the alleged mark STICK TOGETHER when used in connection with the parties' respective products and services;
3. the Board dismiss Opposer's opposition with prejudice and pass Application Ser. No. 77081277 to issue; and
4. the Board cancel Opposer's U.S. Trademark Registration Nos. 3321524, 3321523, 3321522 and 3363610.

The Board is authorized to charge the official filing fee for Applicant's Counterclaim to USPTO Deposit Account No. 033975, Reference No. 053321/0000002.

Dated: March 31, 2008

Respectfully Submitted,

MARK/SPACE, INC.

By: 

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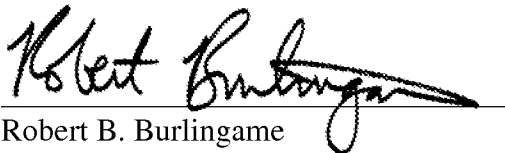
PROOF OF SERVICE BY FIRST-CLASS MAIL

I, Robert B. Burlingame, the undersigned, hereby certify and declare under penalty of perjury that the following statements are true and correct:

1. I am over the age of 18 years and am not a party to the within cause. I am employed by Pillsbury Winthrop Shaw Pittman LLP in San Francisco, CA.
2. My business address is 50 Fremont Street, San Francisco, CA 94105. My mailing address is P.O. Box 7880, San Francisco, CA 94120-7880.
3. On March 31, 2008, I served a true copy of the attached document titled exactly "Answer & Counterclaim to Notice of Opposition" by placing it in an addressed and sealed envelope and transmitting it by first-class mail, to the following:

John C. Rawls
Fulbright & Jaworski, LLP
555 South Flower Street, 41st Floor
Los Angeles, CA 90071

I declare under penalty of perjury that the foregoing is true and correct. Executed this 31st day of March, 2008, at San Francisco, CA.


Robert B. Burlingame